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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 416

ZERO MANUFACTURING COMPANY, INC., *Petitioner*

v.

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Petitioner, Zero Manufacturing Company, Inc., a corporation of Missouri, prays that writ of certiorari issue to review the decision of the United States Court of Appeals for the Fifth Circuit dated March 22, 1966, and the order denying the Petition for Rehearing entered May 2, 1966. Mr. Justice Black granted an application for extension to August 5, 1966, in which to file a petition for writ of certiorari.

OPINIONS BELOW

The opinion of the District Court (R. 785), printed in Appendix A hereto, *infra*, p. 1a, is reported in 232 F. Supp. 720. The opinion of the Circuit Court of Appeals (R. 802), printed in Appendix A hereto, *infra*, p. 10a, is reported in 358 F. 2d 853.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered on March 22, 1966, (R. 817), p. 22a, *infra*. Rehearing was denied on May 2, 1966 (R. 835), p. 23a, *infra*. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

I.

Whether a finding by the trial judge that the subject matter of a patent was obvious to a person having ordinary skill in the art at the time the invention was made may, in view of 35 U.S.C. 103, be based on an opinion of a person admittedly unskilled in the art to which the subject matter of the patent pertains.

II

Whether initial doubt as to the utility of an invention later followed by wide acclaim is a secondary consideration which weakens the presumption of validity of the patent covering the inventive concept.

III

What evidence is sufficient to show a "long felt want" for an invention?

STATUTE INVOLVED

The primary statutory provision involved is Section 103, Title 35, United States Code, 66 Stat. 798, which reads as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

The subject matter of the patents in this case relates to dairy farm equipment. The product standards of this industry are dominated by a public interest for sanitation.

Petitioner in this case was a small family-owned corporation of Washington, Missouri, which manufactured coolers for milk cans. In the early 1950's, the Zero Manufacturing Company had approximately fifty employees. (R. 318, 319.)

In September of 1952, Mr. Duncan applied for a patent on a vacuum container milking system and in the autumn of 1953, petitioner's bulk milk tank vacuum system was introduced to the trade. (R. 319.) The initial reactions of the trade to the utility of petitioner's system were less than enthusiastic. (R. 321-325, 396-398.) Borden Company said they would not accept milk from petitioner's tank. (R. 323.) The 3-A Sanitary Standards for Farm Holding and/or Cooling Tanks in 1953 had no provisions for vacuumized tanks. (P. Ex. 35.) Sanitarians were skeptical as to whether the interior of the tank could be inspected and cleaned. (R. 397.) It was charged that the system would cause bad odors in the milk. Pictures were circulated of people getting stuck in the openings of the vacuum tank. (R. 324.) The tank was called a "submarine" and it was joked that if

you had a youngster or midget, he could get inside to wash the tank. (R. 398.)

In short, there initially was both considerable doubt and even laughter.

But, the acceptance of petitioner's invention by the dairy farmer and later by the trade was and has continued to be dramatic. The sales by petitioner of bulk milk vacuum tanks increased from practically nothing to a gross over $3,000,000 per year in 1960. Moreover, the vacuum tank has increased in popularity in comparison with its competitor, the atmospheric bulk milk tank, with the trend towards petitioner's invention. (R. 405, 418, 419.) The competitive atmospheric bulk milk farm tank system was first introduced by Lucerne Milk Company in 1941. (R. 351.)

By 1960, the number of petitioner's employees had tripled. (R. 319, 320.) The 3-A Sanitary Standards for Farm Cooling Tanks were revised to include specifications for vacuum tanks. (P. Ex. 36.)

The invention is advantageous in that it eliminates the necessity for a releaser which costs from $150-$500 (R. 402, 404); dust, insects, and small animals are excluded from the tank (R. 402, 413); it lends itself better to CIP (clean-in-place) systems (R. 362, 402); contrary to early allegations, the invention does not adversely affect the milk odor, but indeed may cause improvement in borderline cases (R. 404, 405); and the vacuum tank, which has to be large enough to receive from successive milkings, provides a vacuum reserve for a pipeline milking system (R. 401).

After a thorough prosecution in the Patent Office with many prior art patents and publications cited, the application was allowed and issued as patent No. 2,702,019 on February 15, 1955. However, upon

further application, a Reissue Patent No. 24,162 was issued on June 5, 1956.

Following the introduction of petitioner's invention to the trade, the access and inspection opening in the tank was criticized as inadequate for inspection of the inside of the tank from the outside. (R. 326, 327.) Faced with this problem, Mr. Lloyd P. Duncan, the son of the inventor of the bulk milk vacuum tank system, designed an opening which included a flange around its top and yet permitted an observer from the outside to inspect the entire inside of the tank's cylindrical interior lining. This became the subject of U.S. Patent No. 2,873,722, which was issued to Petitioner February 17, 1959.

Among the competitors of petitioner is the Paul Mueller Company which manufactured holding or bulk milk tanks of the atmospheric type prior to 1959. In March, 1959, Mueller procured one of petitioner's tanks which was brought to its plant, tested and cut apart. (R. 111-114, 516, 518, 519; P. Ex. 11.) Subsequently, a bulk milk vacuum tank very similar to petitioner's was introduced to the trade by Mueller.

The Mueller tank was not, however, a direct infringement of petitioner's patent claims which are directed to the vacuum bulk milk tank *system* and include not only the tank, but also the teat cups and the various conduits which connect to the vacuum tank. (P. Ex. 37.)

Mueller entered into an agreement whereby it supplied infringing tanks to respondent, which were in turn offered for sale, sold and actually installed by respondent with the complete system as covered by petitioner's claims. (R. 16, 43.)

Upon learning of the foregoing, petitioner promptly initiated a patent infringement suit against the respondent based upon Reissue Patent No. 24,162 and Patent No. 2,873,722. (R. 301.)

In the trial of this case the petitioner presented four witnesses. Two of the witnesses were experts, Professor March and Mr. Goldberg. Mr. Goldberg is a retired Primary Examiner of the Patent Office. He has an engineering degree and a law degree. He was an Examiner in the Patent Office a total of 38½ years and a Primary Examiner of Division 1 for a period of 17 years. He also served as an acting member of the Patent Office Board of Appeals and acted as an instructor for young Examiners in a training status. He appeared before the United States Senate and House Judiciary Committees along with the Commissioner of Patents and received the U.S. Department of Commerce award and medal for meritorious performance of duties as a Primary Examiner. His division examined arts which included agricultural machinery, food apparatus, and sanitation and plumbing. (R. 427-432.)

Mr. Goldberg had previously inspected milking systems sold by respondent and his testimony related the elements of such system to the claims of petitioner's patent. (R. 437.) Mr. Goldberg considered all of the art cited in the patents, the art furnished by the respondent at pre-trial, and the art listed and furnished by respondent's attorney before the trial, and in his expert opinion testified that the most pertinent art was considered in the examination of both patents by the Patent Office. (R. 436, 482.) He also testified in his expert opinion that the apparatus and system

sold by respondent read upon the claims of the reissue patent and the 2,873,722 patent. (R. 436, 482.)

The petitioner's other expert witness, Professor Richard P. March of Ithaca, New York, was an associate professor at New York State College of Agriculture at Cornell University in Ithaca. At the time of testifying he was on a leave of absence while serving with the Department of Agriculture and Markets on a special project. He holds a B.S. degree in Dairy Industry from the University of Massachusetts and a Master's degree in Dairy Science from Cornell University. He has taught courses concerning the dairy industry and has written approximately thirty articles pertaining to the subject of farm bulk milk tanks and is a member of a number of committees dealing with this subject. (R. 383-385.)

Professor March traced the background of the bulk milk tank system and compared the system wherein cans were utilized with the bulk milk tank system, citing the advantages and disadvantages of each. (R. 386-396.) He also compared the Zero system wherein a vacuum bulk tank was used with the system wherein an atmospheric bulk tank was used. (R. 398-405.) He testified as to the initial resistance encountered by the Zero tank when it was first introduced and was very conscious of the fact that the vacuum tank had been gaining in popularity. (R. 397, 405.)

The respondent called a single expert witness, Mr. Don A. Fischer, Dean of the School of Engineering at Washington University. Dean Fischer's background was as a practicing patent attorney from 1935 to 1941 when he left private practice to become an instructor at Washington University, St. Louis, Missouri. He

has had considerable experience as a witness in patent cases. However, he was admittedly not an expert in dairy equipment. (R. 622-626.) Nevertheless he testified, over petitioner's objection, that in his opinion both of petitioner's patents were invalid in view of the prior art. He did not, however, disagree with Mr. Goldberg that the Patent Office cited the most pertinent prior art. (R. 659, 670.)

No one has questioned the novelty, per se, of petitioner's patents. Instead, they were held invalid over a combination of references. The only evidence to support the trial court's findings that petitioner's inventions were obvious is that adduced from Dean Fischer. Although petitioner has assiduously pointed out to the courts that respondent presented *no* evidence that the subject matter claimed would be obvious to *a person having ordinary skill in the particular art involved,* this evidentiary gap has been ignored by the courts. Instead, the trial court's decision was based upon a now defunct interpretation of the *Great A&P Tea Co.* v. *Supermarket Equipment Corp.,* 340 U.S. 147 (1950) to the effect that where there is no new result in a patented combination, a patent is not valid. (R. 793.) In contrast, the appellate court found that the secondary considerations militated against the petitioner. Thus, the Circuit Court of Appeals found nonobviousness because of the early opposition by the industry to petitioner's invention despite its later acclaim. It also found that there was no evidence that industry needs were urgently felt, or that others had long sought the claimed new development. (R. 810.)

REASONS FOR GRANTING THE WRIT

In the recently decided cases of *Graham* v. *John Deere Co.,* 15 L. Ed. 2d 545, and *United States* v. *Adams,* 15 L. ed. 2d 572 (1966), this Court found that prior tests of patentability applied by the Fifth and Eighth Circuits were in error and the opinions of Mr. Justice Clark set forth the following elementary requirements for patentability:

1. The patent must issue to the inventor, a requirement derived out of the Constitution.

2. The novelty requirements of 35 U.S.C. 102 must be met.

3. The invention must be useful, 35 U.S.C. 101.

4. The invention must meet the requirements of the newly added statutory dimension of 35 U.S.C. 103.

Mr. Justice Clark said in effect that section 103 codifies the cornerstone of the judicial evolution of patentability. It provides a functional approach.

Section 103 requires that the differences between the subject matter patented and the prior art be such that the subject matter as a whole would not have been obvious at the time the invention was made *to a person having ordinary skill in the art to which said subject matter pertains.* By the sanctioning of the criteria of Section 103, both in *Graham* v. *John Deere Co.* and *United States* v. *Adams, supra,* it would seem to follow as a corollary that there must be evidence as to what would be obvious to a person having ordinary skill in the art to which the invention pertains at the time it was made in order to negative patentability. This in turn would appear to require an evidentiary basis from a person skilled in the art to which the in-

vention pertains, and without such, a finding that the invention was inobvious would appear to be unsupportable. Section 103 was so interpreted in *L-O-F-Glass Fibers Co.* v. *Watson,* 228 F. 2d 40 (D.C. Cir., 1955). This interpretation is fortified by consideration of 35 U.S.C. 112 which requires that the written description of an invention be such as "to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." It has been held that the question of whether the specification in a given patent is self-sufficient is one of evidence. *Loom Co.* v. *Higgins,* 105 U.S. 580, 586 (1881). The affirmative defense that it is insufficient can be supported by no evidence except that of a person skilled in the art to which the invention pertains, or with which it is most nearly connected. *Anraku* v. *General Electric Co.,* 80 F. 2d 958, 963, (Cir. 9, 1935), *cert. denied,* 298 U.S. 678. The "person skilled in the art" to whom a patent for cutlery steel is addressed is not the cutler who makes the article but is the metallurgist who makes the steel. *Am. Stainless Steel Co.* v. *Ludlum Steel Co.,* 290 Fed. 103, 107 (Cir. 2, 1923). Cf. *Walker on Patents,* Deller's Edition, Volume III, Section 728; Historical and Revision Notes, 35 U.S.C.A. 112.

The instant case is not an isolated one where the so-called expert in the art is called to testify by reason of his skill in articulation rather than in the art involved. In the instant case, Dean Fischer candidly stated, "I don't pretend in any way to be an expert in the dairy industry art, even though I live on a farm." (R. 625, 626.) In addition, he had testified as an expert in about one patent suit a year over a period of twenty years involving such arts as a mixer for a soda fountain counter to serve Coca Cola, coin game devices,

vending machine art, and automobile transmissions. (R. 623-625.) It will thus be understood that Dean Fischer and many others like him are essentially professional experts for patent cases. Since the trial judge will not be skilled in the art in any significant number of cases, it is often a case of the blind leading the blind insofar as the skill in the art is concerned.

This Court at page 566 of *Graham* affirmed Mr. Justice Frankfurter's observation that the judiciary "is most ill-fitted to discharge the technical duties cast upon it in patent litigation." In *Safety Car Heating and Lighting Co., Inc.* v. *General Electric Corporation,* 155 F. 2d 937 (Cir. 2, 1949) Judge Learned Hand stated, "Courts made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in fields with which they cannot be familiar."

It is high time that courts insist upon what any high corporate executive insists upon in making important decisions, that is, that they be advised by real, not bogus experts. Such an insistence should minimize clear technical types of errors (to those actually skilled in the art) as are abundant in this case, the worst of which are outlined on pages 825-828 of the record.

II

In the case of the *United States* v. *Adams, supra,* Adams brought his discovery to the attention of the Army and the Navy. Signal Corps scientists did not believe that the battery was workable. It was not until approximately two years thereafter that the Signal Corps concluded that his battery was feasible. Subsequently, the battery earned high acclaim. In the instant case, the fact that petitioner's device found a great deal of opposition in industry and it was only

after several years of use that it reached its present state of acclaim was considered a factor to militate against the conclusion of "nonobviousness." (Appendix A, page 17a). However, the fact that the trade was first doubtful of utility was considered to be pretty clear proof that it was not something that was obvious or involved mere mechanical skill in the case of *McKee* v. *Graton & Knight Co.*, 85 F. 2d 262, 264 (Cir. 4, 1937). From a logical standpoint, it is submitted that scoffing and criticism which ultimately become acclaim and praise should be considered even a higher tribute to an invention than immediate acclaim, since it is more indicative of inobviousness. Such import was read into the Adams case by the petitioner. However, as can be seen, the Circuit Court of Appeals has used the circumstance for the opposite purpose, that is, to indicate obviousness. Accordingly, it is urged that the holding by the Circuit Court of Appeals of the instant case is in direct conflict with this Court in *Adams*.

III

Commercial success in this case has been great, as demonstrated by Plaintiff's Exhibit 37 and outlined in the Record, pages 318-321. However, the Circuit Court of Appeals has held that there "was no showing that the industry needs were urgently felt."

What is required to show "long-felt want"? In the case *Reiner* v. *I. Leon Co.*, 285 F. 2d 501 (Cir. 2, 1960), *cert. denied*, 366 U.S. 929, it appears that the evidence of satisfaction of a long-felt want constituted: (1) the fact that a need for curl clamps existed and (2) that existing devices yielded to the Reiner disclosure. In the case of *Norman* v. *Lawrence*, 285 F. 2d 505 (Cir. 2, 1960), which immediately follows *Reiner* in the Federal Reporter, Judge Hand applied the meas-

ure of whether a need had long existed in a "combination of the simplest sort, made of elements that had for many years been used in industry," on the basis that the combination solved the problem and was a commercial success. The lower court's inference drawn from proof of commercial success to the effect that the patent met "a long-standing need" was apparently affirmed. See: 180 F. Supp. 186, 188.

In the instant case, the testimony from Professor March disclosed: (1) a need for bulk milk tank milking systems and (2) that existing systems are yielding to that of the petitioner. Additionally, there was a problem of the releaser which was not only a costly item but could cause rancidity in the bulk milk tank system, the fact that existing tanks were not proof against insects, small animals, etc., and other problems which had existed since 1941 when the bulk milk tank system was introduced. These problems were solved by the patented vacuum bulk milk tank system of the petitioner. Such solutions coupled with evidence of commercial success would, it would seem, be acceptable and ample evidence pursuant to the criteria of *Reiner* that petitioner's devices were the answer to a "long-felt want."

It is submitted that the Circuit Court of Appeals does not know what is required for a showing of a "long-felt want" and in one of its first decisions after *Graham* and *Adams* has created an unnecessary conflict between it and the Second Circuit in this respect.

Summation

This is a case where the trial judge held patents to be invalid on a basis of no better art than was cited before the Patent Office and on the testimony of a

person admittedly not skilled in the art. Thereafter, although the petitioner has become a definite community asset in a small town because of its patented innovations, and although the secondary considerations which indicate patentability of petitioner's inventions read almost like a textbook listing of same, the appellate court found them to be evidence of obviousness within the meaning of Section 103. It is submitted that the trial court did not give the petitioner a fair trial inasmuch as it based its conclusions on untrustworthy evidence and that the appellate court not only failed to recognize the fallacies of the lower court, but additionally has changed the significance of evidence which should be considered favorable to patentability under Section 103 to the opposite effect.

Statistics of the percentage of cases held valid and infringed by the various federal circuit courts of appeal in the period of 1953-1963, show a variance of zero per cent for the District of Columbia Circuit and ten per cent for the Eighth Circuit up to as high as fifty-seven per cent for the Tenth Circuit. *Journal of the Patent Office Society,* April 1966, Vol. XLVIII, No. 4, page 216. Thus there is variation by almost a factor of six between the Eighth and Tenth Circuit. There is no acceptable excuse for such variations. If the courts will follow Section 103 in a journeyman-like fashion, there should be no significant variations between them. But if the courts are again to gallop in all directions, the uneven pattern will undoubtedly continue. The instant case demonstrates the clear need of judicial instructions to the federal courts on *how* to follow Section 103, having been informed of its applicability in *Graham* and *Adams.*

CONCLUSION

For the foregoing reason, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI—JACKSON DIVISION

(Civil 2954)

ZERO MANUFACTURING COMPANY, INC., *Plaintiff*

v.

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Defendant*

* * * * * * * * * *

Opinion

FINDINGS OF FACT AND CONCLUSIONS OF LAW

(Number and title omitted)

(Filed: April 10, 1964)

This is an infringement patent suit by the Zero Manufacturing Company, Inc., a concern which manufactures bulk milk vacuum tanks and holds patents relating to such tanks, against the Mississippi Milk Producers Association, a Mississippi cooperative association which has sold like bulk milk vacuum tanks manufactured by the Paul Mueller Company. The Paul Meuller Company has undertaken the defense of this case.

The patents involved are United States Letters Patent Reissue No. 24,162, issued June 5, 1956, to G. R. Duncan which relates to a vacuum container milking system and apparatus therefor, and United States Letters Patent No. 2,873,722, issued February 17, 1959, to L. L. Duncan et al. which relates to a particular opening in the bulk milk tank. Both patents have been assigned to Zero Manufacturing Company, the plaintiff herein.

Plaintiff contends that defendant infringed both of the foregoing patents by selling the bulk milk vacuum tank manufactured by the Paul Mueller Company together with

apparatus therefor. The plaintiff contends now that it is entitled to a preliminary and final injunction against any further infringement by the defendant.

In September of 1952 Mr. Duncan applied for a patent on a vacuum container milking system and apparatus therefor which he had developed. In a spirited prosecution, the application was considered and rejected on three occasions, June 12, 1953, January 26, 1954 and March 15, 1954, but finally, on May 20, 1954, an allowance was issued. In the course of the prosecution several references were considered by the Examiner. These references included Mr. Duncan's previous patents wherein he applied a vacuum system to milk cans, and the U.S. Patents to Devore, Bannister, et al, Wachowitz, McGovern and Greene, together with a French patent No. 963,212, and a publication concerning the Byvac milking system, all of which involved the utilization of vacuum within a milk container whereby milk was drawn from the farm animal to the container. Several other patents were also cited. Following allowance, the patent was issued as No. 2,702,019 on February 15, 1955.

In the autumn of 1953 Duncan's invention of the bulk milk vacuum tank was introduced to the trade. It was financially successful.

Less than one year following the issuance of patent No. 2,702,019 Duncan, on January 10, 1956, applied to have his patent reissued with additional claims. This application was initially rejected as to the added broader claims, but was eventually allowed and reissued June 5, 1956.

In bulk milk tanks, accessibility for cleaning and inspection purposes is important. The original openings of plaintiff's tank were rectangular with radius corners. Duncan found that they could advantageously substitute an oval "Swoop-down" opening structure for the rectangular openings with sloping interior portions. This became the subject matter of Patent No. 2,873,722, which was applied

for on November 22, 1957. The application was initially rejected May 16, 1958, with the Examiner contending that there was no invention involved in shaping the apparently elliptical opening enclosure members so that they would take the contour of the opening in the cited Schravesande patent.

Defendant contends that the patents in issue are invalid because not patentable in view of the prior art. It also denies infringement. It contends the '722 patent is invalid because it claims an aggregation and cites the case of A & P Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147. It also contends that the presumption of validity is destroyed by the failure to cite patents showing the prior art.

Following the submission of this response, the application was allowed and it issued as a patent February 17, 1959.

The reissue patent, No. 24,162, relates to a refrigerated vacuum tank milking system. It comprises two general parts: (1) a milking system, and (2) a refrigeration system.

In this reissue patent the milk lines lead from teat cups and are connected to the interior of the milk receptacle. The vacuum line, which is connected to a vacuum source, draws and maintains a vacuum on the interior of the milk receptacle. The vacuum thus maintains a vacuum on the interior of the milk receptacle and on the milk lines to draw milk into the receptacle.

The refrigerating system of the reissue patent consists of a compressor-condenser with a copper cooling tube leading from the compressor-condenser and wrapped around the outer surface of the milk receptacle. The compressor-condenser circulates refrigerant through the copper tube across the surface of the milk receptacle and back to the compressor-condenser. This cools the milk

receptacle. The second part of the refrigeration system is the milk cooler which consists of a separate box with insulating walls in which the milk receptacle is placed. As the milk receptacle is cooled, the milk cooler will retain the cooling for more efficient refrigeration. There is an agitator or stirrer driven by a motor in the bulk milk receptacle for the purpose of circulating the contents for uniform cooling.

The testimony at the trial revealed that the patent office Examiner cited several prior art patents against the application of the Duncan reissue patent, but that neither the Uphaus patent No. 1,603,429, issued on October 19, 1926, nor the McDonald patent, No. 2,207,928, issued on July 16, 1940, was cited.

The Uphaus patent discloses a complete vacuum milking system. The milk lines that lead from the teat cups are connected directly to the interior of the milk receptacle, which is a large cylindrical tank. The vacuum line is connected directly to the interior of the receptacle to maintain a vacuum in the receptacle and to draw milk into the receptacle from the teat cups. The Uphaus patent has no refrigerating means.

The McDonald patent also discloses a complete vacuum milking system. The milk line leading from the teat cups is connected directly to the interior of the milk receptacle. The vacuum line is connected to the interior of the milk receptacle to maintain a vacuum therein while drawing the milk into the receptacle from the milk line. Although no refrigerating means is shown, McDonald recites that his apparatus can be used with or without a cooler.

The operation of the vacuum milking system of both Uphaus and McDonald is exactly the same as that disclosed by the Duncan reissue patent. The testimony is abundantly clear that anyone with ordinary skill in the art could apply a refrigerating system to a vacuum bulk milk tank like either Uphaus or McDonald.

Refrigerated atmospheric bulk milk tanks were widely known and used prior to the Duncan reissue patent. Let's look at two examples that were cited by the Examiner against the Duncan reissue patent.

First, Wachowitz, No. 2,266,134, issued in 1941, shows a cylindrical, horizontal tank, having domed ends, an agitator, an inner shell surrounded by insulation and an outer shell. It has a refrigeration coil arrangement.

Next, McGovern, No. 2,617,264, shows a horizontal, cylindrical tank with domed ends and an inner shell surrounded by insulation and an outer shell. It has a refrigerating means between the inner and outer shells.

After reviewing the prior art patents as revealed at the trial and in the briefs, the Court finds as a fact that one with the ordinary skill of the art could add a refrigerating means, as taught by Wachowitz or McGovern, to a vacuum bulk milk tank as taught by Uphaus or McDonald. Conversely, one with the ordinary skill of the art could add a vacuum milking system, as taught by Uphaus and McDonald, to a refrigerated atmospheric bulk milk tank as taught by Wachowitz and McGovern.

We come now to the Duncan patent, No. 2,873,722, issued February 17, 1959, which relates to a particular opening in the bulk milk tank. This opening is referred to as a "swoop down" opening. The opening is *elliptical* in shape, with the sides lower than the ends. It is alleged that the opening makes for better visibility inside the tank and better cleanability of the tank.

In the Nitch patent, No. 1,437,857, issued December 5, 1922, which was not cited by the Examiner, an opening in a cylindrical boiler is shown of elliptical shape with swoop down sides. The utility of the Nitch opening is for better cleaning and better inspection after cleaning. Although it is not a milk tank, the purpose of the Nitch opening is substantially the same as that shown in the Duncan patent, No. 2,873,722.

Testimony at the trial revealed and the Court finds as a fact that it is impossible to make a hole in a cylindrical tank without having the sides lower than the ends. The Court also finds as a fact that the swoop down opening for the purpose of inspection and to facilitate cleaning of the tank was taught by F. O. Nitch patent No. 1,438,857.

I have considered the record, the briefs, and the authorities cited therein and am of the opinion that the patents in question are invalid. The main issue in the case, as it narrows down, presents simply a question of fact, and the question for determination is whether the patents are invalid. If they are invalid, then it is not necessary to determine whether or not there was infringement, because if I am correct in holding their invalidity, they could not be infringed.

The law is well settled that it is not invention to use an old process or an old machine for a new and analogous purpose. The claimed patents here in question were clearly taught in the prior art and a result was there reached which well could have been anticipated. There was no inventive faculty. Fluor Corp. Ltd. v. Gulf Interstate Gas Co., 259 Fed. (2) 405.

Moreover, it is well settled that there is a presumption of validity which attends the grant of letters patent by the Patent Office, but such presumption can be overcome if invalidity is proved beyond a reasonable doubt. The fact that there has been commercial success will not create patentability, for creative genius is needed. The defense of anticipation in the art precludes creative genius that is essential to patentability. Bufkin R. Fairchild v. Joe A. Poe, 259 Fed. (2) 329.

In this case the prior art, as has been discussed in my findings of fact, precludes the validity of the patents here in question. In the case of The Great Atlantic & Pacific Tea Company v. Super Market Equipment Corporation,

340 U.S. 147, it is held that the mere combination of a number of old parts or elements which in combination perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention. In this case here before the court the patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly. This will not do, as was held in the A & P case, supra.

The patents in question not being valid, it is not necessary to discuss the law with reference to infringement or copying. All those matters have been considered carefully in this case, along with all of the evidence and exhibits, and after consideration thereof, I am of the opinion that the patents are invalid, and now make the following conclusions of law:

CONCLUSIONS OF LAW

1. The Court has jurisdiction.

2. The law is well settled that the grant of a patent creates a prima facie presumption of validity. However, the presumption of prima facie validity is greatly weakened, if not destroyed, when pertinent prior art is not considered by the patent office. Gomez v. Granat Bros., 177 Fed. (2) 266 (1949); Patent was not entitled to presumption of validity over prior art which Examiner did not note. Nordell v. International Filter Co., 119 Fed. (2) 948 (1941). In the present case the Examiner did not cite the following patents:

Uphaus	No. 1,603,429
McDonald	No. 1,207,928
Nitch	No. 1,437,857

In so far as there has been an "anticipation", meaning disclosure in the prior art of a thing substantially identical

with the art or instrument for which a patent is sought, the inventor is not entitled to a patent, and a patent, if granted, is invalid. 69 CJS § 20.

In Fairchild v. Poe, 259 Fed. (2) 329 (1958), Judge Wisdom of the Fifth Circuit Court of Appeals quoted Lyman Gun Sight Corp. v. Redfield Gun Sight Corp., 87 Fed. (2) 26, (1936), Tenth Circuit, as follows: "Where a patent includes a combination of elements, it is not necessary to establish anticipation that all of the elements be found in a single earlier patent or in a single device previously in general use. It is enough if the evidence, taken as a whole, discloses that all of the claimed elements are found in different prior patents in the art or in different devices previously in general use, and no new functional relationship arises from their combination."

3. The Court concludes as a matter of law that the vacuum milking system of the Duncan reissue patent, No. 24,162, was anticipated by both Uphaus patent No. 1,603,429 and McDonald patent No. 2,207,928.

4. The question of invention is determined in the light of all the knowledge of the prior art, whether or not the alleged inventor actually had such knowledge; and invention is not present if a person skilled in the art, having the prior disclosures before him, would find the process or device in question obvious. 69 CJS § 53(b).

Patentable invention does not reside in a method or device which is the product of mere mechanical skill representing the solution of a problem which could have been similarly solved by those skilled in the art to which it relates. 69 CJS § 55.

5. The Court concludes as a matter of law that it would not require inventive skill, but merely the ordinary skill of the art to add a refrigerating means to a vacuum bulk milk tank as disclosed in Uphaus and McGovern. The art of refrigerating bulk milk tanks was taught in both the

Wachowitz patent, No. 2,266,134, and the McDonald patent, No. 2,617,264. The Court further concludes that only the ordinary skill of the art would be required to transform the refrigerated atmospheric bulk milk tanks of Wachowitz and McGovern into vacuum bulk mix tanks as taught by Uphaus and McDonald.

6. As to the Duncan patent, No. 2,873,722, the Court concludes as a matter of law that, in view of the teaching of Nitch patent, No. 1,437,857, only the ordinary skill of the art would be required to put such an opening in a bulk milk tank as seen in the Duncan patent.

7. The Court concludes as a matter of law that both the Duncan reissue patent, No. 24,162, and the Duncan patent No. 2,837,772, are invalid for the afore-mentioned reasons as heretofore stated.

The law is well settled that commercial success cannot render valid a patent otherwise invalid.

8. On the question of infringement, the Court concludes as a matter of law that "once a court in an infringement suit finds that patent is invalid, it need not proceed to determine the question of infringement, since a finding of invalidity precludes existence of anything which could have been infringed." Thys Co. v. Oeste, 111 F. Supp. 665 (1953), and the authorities therein cited.

The litigants in this case have been sincere in their contentions and if I am correct in my holding, the decision will be valuable to both parties in that they know where they are. For that reason, I will tax the costs that accrued at the instance of plaintiff against the plaintiff and the costs that accrued at the instance of the defendant will be taxed against the defendant.

An order may be drawn in accord herewith.

s/ S. C. Mize
United States District Judge

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 21624

ZERO MANUFACTURING COMPANY, INC., *Appellant,*

versus

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Appellee.*

Appeal from the United States District Court for the Southern District of Mississippi

(March 22, 1966.)

Before WISDOM and COLEMAN, Circuit Judges, and DAWKINS, District Judge.

DAWKINS, District Judge: This action was brought by Zero Manufacturing Company, Inc., under 35 U.S.C. §§ 271, 281 alleging the infringement of two patents[1] by Mississippi Milk Producers Association, a Mississippi cooperative which sold and installed milking equipment, manufactured in large part by the Paul Mueller Company, who undertook its defense.

The District Court found both patents to be invalid under 35 U.S.C. § 103, as anticipated by the prior art, thus making it unnecessary to reach the infringement issue, and dismissed Zero's complaint. We affirm.

[1] The patents in suit are: United States Letters Patent Reissue No. 24,162 issued June 5, 1956, to G. R. Duncan, and United States Letters Patent No. 2,873,722, issued February 17, 1959, to L. L. Duncan et al.

The facts may be quickly capsulated. After three rejections, G. R. Duncan was issued a patent relating to a vacuum container milking system and apparatus therefor on May 20, 1954, which was reissued with additional claims June 5, 1956. The second patent relates to an elliptical opening in a cylindrical milk tank, which, after one rejection, was issued February 17, 1959. Both patents have been assigned to Zero, who, since 1953, has been successful in the manufacture and sale of the bulk milk vacuum tank unit.

Prior to introduction of the refinements here in issue, the dairy industry was familiar with various milking procedures. The vacuum milking machine, or pipe line milker, with its teat cup assembly attachable to the cow's udder, was in wide usage. Milk was drained into a pail, often slung around the cow's middle, from which it was poured into the familiar five gallon milk can. These cans were convenient both for cooling and transporting milk. However, it often was more convenient, both for the farmer and the trucker, to utilize a larger container; thus the industry saw wide use of the bulk milk tank and the tank truck. Doing away with the milk cans was as welcome as the availability of milking machines. Moreover, the less exposure of milk to unsanitary conditions present in the atmosphere, such as dust and insects, during its movement from cows to processing plant, the better. Proper sanitation also requires that the whole system, particularly the tank, be easily accessible for cleaning by the farmer.

The system here in issue achieved high sanitary conditions in the milking, cooling and storing process performed by the farmer prior to transportation, in that the system was hermetically sealed. It included the teat cup assembly, hoses or lines through which the milk flowed under vacuum, and a milk tank in which milk was cooled, agitated to keep it from separating, and stored. When the tank was empty, the large elliptical opening in it facilitated cleaning and inspection.

The subject matter of the reissue patent comprises two parts, the milking system and a refrigerating means. The former includes a cylindrical vessel with domed ends into which the milk lines and a vacuum line are inserted. When a compressor creates a vacuum inside the vessel, milk is drawn through the lines into the tank. The refrigerating system includes a compressor-condensor which circulates a refrigerant through coils around the tank, to cool the milk therein. The subject matter of the '722 patent relates merely to the oval-shaped opening on the top of the cylindrical vessel which facilitates cleaning and inspection of the interior. Appellant refers to this opening as a "'swoop down'' opening whose asserted patentable quality is the fact that its sides are lower than its ends, which allows a milk inspector to view the entire interior of the tank from outside.

The basic statutory provisions under which this controversy has arisen are found in Title 35 of the United States Code. Sections 101 and 102 prescribe the requirements of *novelty* and *usefulness* in subject matter capable of being patented and section 103 provides, in effect, that a patent may not be obtained when the subject matter claimed would be *obvious* to a person having ordinary skill in the particular art involved. A concurrence of these three explicit conditions is necessary for patentability. *Graham* v. *John Deere Co.*, — U.S. —, 34 *Law Week* 4119 (February 21, 1966).

A wealth of jurisprudence exists in this area of patent law. Since *Hotchkiss* v. *Greenwood*, 52 U.S. 248 (1850), it has been recognized that if an improvement is to obtain the privileged position of a patent, more ingenuity must be involved than the mere work of a mechanic skilled in the art. See *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941).

It is axiomatic that a patent should not be granted for the discovery of a result that would flow naturally from

teachings of the prior art. To do nothing more than combine the teachings available in a manner which would have been obvious to one skilled in the art, even though the device has unexpected advantages, does not create a patentably new invention. For example, in the case of *In re Crockett,* 279 F. 2d 274 (Cust. & Pat. App. 1960), it was held that where the idea of combining ingredients would flow logically from the teachings of the prior art, a claim to their joint use is not patentable.

On the other hand, even though all the constituents in a new assemblage may be old, if their new concourse would not have been obvious at the time the invention was made to a person having ordinary skill in the art, there is patentability. *Reiner* v. *I. Leon Co.,* 285 F. 2d 501 (2 Cir. 1960), cert. den. 366 U.S. 929 ("clamps" used to maintain "formed curls" in a woman's hair). Similarly, in *Oliver United Filters, Inc.* v. *Silver,* 206 F. 2d 658 (10 Cir. 1953), a combination of known elements was held patentable as having produced such a new and improved result over anything existing in the prior art. There a process for extraction of sugar from a sugar beet solution was so novel and long-sought in the industry, that the combination device was found to constitute patentable invention.

The Supreme Court now has affirmed the principle that a combination of known elements may be patentable if it satisfies the requisite conditions. Thus in *United States* v. *Adams,* — U.S. —, 34 *Law Week* 4132 (February 21, 1966), the Court had before it a patent on a "non-rechargeable, as opposed to a storage, electrical battery," which consisted of two electrodes—one made of magnesium, the other of cuprous chloride—which are placed in a container of either plain or salt water as battery fluid. In upholding the validity of the Adams patent, the Court held:

> "We conclude the Adams battery was also non-obvious. As we have seen, the operating characteristics of the Adams battery have been shown to have been

unexpected and to have far surpassed then-existing wet batteries. Despite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them together as did Adams required that a person reasonably skilled in the prior art must ignore that (1) batteries which continued to operate on an open circuit and which heated in normal use were not practical; and (2) water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium. These long-accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by Adams. This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable innovation. We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness." — U.S. at —, 34 *Law Week* at 4135.

Until recently, the leading case in this area was *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*,[2] where a three-sided rack on a supermarket checkout counter was held unpatentable as merely an aggregation of old elements. After a lapse of 15 years, the Supreme Court now has re-examined the statutory and judicial tests of patentability in *Graham* v. *John Deere Co., supra,* and announced what definitive tests of patentability

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[2] 340 U.S. 147 (1950). "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans." *Id.* at 152. See also *Aetna Steel Products Corp.* v. *Southwestern Products Co.*, 282 F. 2d 323 (9 Cir. 1960).

are now required under the 1952 enactment of 35 U.S.C. § 103.

One of the three cases decided by the Supreme Court, consolidated for argument, was an infringement action which had presented a conflict between two Circuits over the validity of a single patent on a "Clamp for vibrating Shank Plows."[3] The subject matter was technical, and it suffices to say that it was acknowledged to be a combination of old mechanical elements whose asserted patentable quality was its improved functional result due to the novel relationship of the old mechanical members of the device. Upon elucidating the new test of "nonobviousness" under § 103, the Court found the combination there at issue to lack that condition of patentability. After a lengthy examination of the legislative history of section 103, the Court stated:

> "Approached in this light, the § 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on nonobviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures. [U.S. Const. art. I, § 8, cl. 8.]
>
> "While the ultimate question of patent validity is one of law, *A. & P. Tea Co.* v. *Supermarket Corp., supra,* at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103,

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[3] In *Jeoffroy Mfg., Inc.* v. *Graham,* 219 F. 2d 511 (5 Cir. 1955), cert. denied, 350 U.S. 826, we held the patent valid under the rule that when a combination produces an "old result in a cheaper and otherwise more advantageous way," it is patentable. The Eighth Circuit had held, in the *Graham* case, that there was no new result in the patented combination, and that the patent was invalid. 333 F. 2d 529, rev'g 216 F. Supp. 272 (W.D. Mo. 1963). The Supreme Court found that neither circuit applied the correct test.

> the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . . ." — U.S. —, 34 *Law Week* at 4123.

Certain "secondary considerations" were quite eloquently stated by Judge Learned Hand in *Reiner* v. *I. Leon Co., supra,* at 503, 504:

> "The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e.g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant? . . ."

With these questions in mind, examination of the record reveals numerous factors which militate toward the conclusion that both the reissue patent and the '722 patent fail to indicate "nonobviousness" within the statutory mean-

ing. There was no showing that the industry needs were urgently felt, *cf. Oliver United Filters, Inc.* v. *Silver, supra,* nor that others had long sought the claimed new development. Rather, it appears that the plaintiff's device found a great deal of opposition in the industry and it was only after several years of use that it has reached its present state of acclaim. *Cf. Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275 (1944), where an improved protective casing for dry-cell flashlight batteries was so quickly and widely accepted that its creators could claim "invention." In the case here presented it appears that even recently plaintiff's device has come under attack for the asserted reason that warm milk from the cow reaching the refrigerated tank may have a pernicious effect upon flavor.

Neither are we convinced that the lower court's conclusion that the two patents were anticipated in the prior art was in error.[4] Briefly, Uphaus, No. 1,603,429, shows a bulk milk receptacle upon which vacuum is maintained directly in order to draw the milk from the cow into the tank. No refrigeration means is shown. McDonald, No. 2,207,928, discloses a complete vacuum tank milking system, noted to be used with or without a cooler. Wachowitz, No. 2,266,134, shows a "direct expansion" type milk tank cooler, and with a slightly different configuration. McGovern, No. 2,617,264, shows an atmospheric bulk milk tank with refrigeration means.

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[4] In *Fairchild* v. *Poe*, 259 F. 2d 329, 332 (5 Cir. 1958), we said: "The essence of patent anticipation cases lies in the fact that the *inventive thought* in both the anticipating and patented devices is the same, not merely that one process might possibly perform another function . . . 'Where a patent includes a combination of elements, it is not necessary to establish anticipation that all of the elements be found in a single earlier patent or in a single device previously in general use. It is enough if the evidence, taken as a whole, discloses that all of the claimed elements are found in different prior patents in the art or in different devices previously in general use, *and no new functional relationship arises from their combination.*'"

With respect to the reissue patent it is difficult to state the conclusion more articulately than did the trial court:

> "After reviewing the prior art patents as revealed at the trial and in the briefs, the Court finds as a fact that one with the ordinary skill of the art could add a refrigerating means, as taught by Wachowitz or McGovern, to a vacuum bulk milk tank as taught by Uphaus or McDonald. Conversely, one with the ordinary skill of the art could add a vacuum milking system, as taught by Uphaus or McDonald, to a refrigerated atmospheric bulk milk tank as taught by Wachowitz and McGovern." 232 F. Supp. at 723.

Similarly, the court below found the '722 patent, involving the elliptical opening in the top of the vessel, invalid as anticipated in the prior art of Nitch, No. 1,437,857, even though that patent concerned a boiler rather than a milk tank. We find ample support in the record for the court's conclusion that:

> "Testimony at the trial revealed and the Court finds as a fact that it is impossible to make a hole in a cylindrical tank without having the sides lower than the ends. The Court also finds as a fact that the swoop down opening for the purpose of inspection and to facilitate cleaning of the tank was taught by F. O. Nitch patent No. 1,437,857." 232 F. Supp. at 723.

Plaintiff's argument in brief that the unique configuration of the flanges which facilitate the sealing of the tank upon the "swoop down" opening does not convince us that the eminent trial judge committed reversible error in concluding that the subject matter of the '722 patent lacked the requisite nonobviousness.

When the facts of the case here presented are held up to the *Graham* test of "nonobviousness," it clearly appears that the scope and content of the prior art were such

that whatever inventive thought the two patents may have evidenced, the subject matter showed no substantial differences from the prior art; and, moreover, with respect to the resulting combination device in the reissue patent, and the "swoop down" opening in the '722 patent, the skill level of neither rose higher than that achieved in the prior art. We are thus impelled to the conclusion that both patents are invalid, as the differences between them and the pertinent prior art would have been obvious to a person reasonably skilled in that art.[5]

In seeking reversal of the court below, appellant argues in brief that "[t]he basic issue before the [district] court was whether defendant succeeded in rebutting the strong presumption of validity that arose in this case in view of the issuance and re-issuance of the patents involved. The finding by the lower Court that such presumption had been rebutted is based upon a misconception of law." Appellant's brief, p. 43.

The contention is two-pronged: First it is urged that the trial judge erred in finding the statutory presumption of validity[6] weakened or destroyed by the failure of the Patent Office to cite the pertinent prior art patents of Uphaus and McDonald for the reissue patent, and Nitch for the '722 patent; and second, that there exist numerous factors which, it is argued, strengthen the presumption of validity concerning the patents here in issue.

The basis for the first contention lies in application of the principle that where the Patent Office has not con-

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[5] See also the well documented decision in *Griffith Rubber Mills v. Hoffar*, 313 F. 2d 1, 5 (9 Cir. 1963): "There was no objective evidence that the combination was less obvious than it appears . . . So far as was shown, Hoffar was the first to make [the device] only because he was the first skilled in the art who directed his attention to the problem. . . ."

[6] 35 U.S.C. § 282: "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. . . ."

sidered pertinent prior art, the statutory presumption of validity is seriously weakened. See *e.g., Murray Co. of Texas, Inc.* v. *Continental Gin Co.*, 264 F. 2d 65 (5 Cir. 1959).[7] Thus appellant argues that the prior art considered by the Patent Office in both the reissue and the '722 patents was at least as pertinent as the art which the trial judge alluded to in his conclusion that the presumption had been rebutted. But even if we agreed with appellant that the prior art considered by the Patent Office was more pertinent than the Uphaus, McDonald and Nitch patents, still the presumption would not be conclusive. See *Graham* v. *John Deere Co.*, 333 F. 2d 529 (8 Cir. 1964), *aff'd* — U.S. — (1966). After a careful consideration of all authorities cited by appellant in support of his contention, we find nothing which convinces us of error in the conclusion of the trial court that the uncited prior art was the more pertinent.

Turning to appellant's second contention, the argument proceeds by analogy to a number of cases holding various factors to have the effect of strengthening the presumption of validity. Thus it is suggested that the utility of the invention along with the fact that the industry did not immediately accept the new device, showed that it involved more than mere mechanical skill and was not obvious.[8] Further, it argues that the imitation[9] and advertisement[10]

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[7] *Cf. Artmoore Co.* v. *Dayless Mfg. Co.*, 208 F. 2d 1, 4 (7 Cir. 1953): "It has been held, and we think with logic, that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked."

[8] See *e.g., Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428 (1911); *The Barbed Wire Patent*, 143 U.S. 275 (1892); *McKee* v. *Graton & Knight Co.*, 87 F. 2d 262 (4 Cir. 1937).

[9] See *e.g., Florence-Mayo Nuway Co.* v. *Hardy*, 168 F. 2d 778 (4 Cir. 1948); *Hazeltine Research, Inc.* v. *Admiral Corp.*, 87 F. Supp. 72 (N.D. Ill. 1950).

[10] See *e.g., Motor Improvements* v. *General Motors Corp.*, 49 F. 2d 543 (6 Cir. 1931), *cert. denied*, 284 U.S. 663.

by the alleged infringer have strengthened presumption. Lastly, appellant urges that commercial success and public acceptance of the device[11] evidence the unobviousness of the invention.

After careful consideration of each and all of these factors, in context, we are not persuaded that the presumption can become so strong as to resist equally strong rebuttal. Application of the facts contained in the record in the case here presented fail to show that the statutory presumption has not been rebutted by substantial evidence. Indeed, as was said in *Griffith Rubber Mills* v. *Hoffar*, 313 F. 2d 1, 5 (1963), "[t]here was no objective evidence that the combination was less obvious than it appears."

What moves us, in the last analysis, is that appellant's device has added nothing to the sum of knowledge in the industry which is so new and useful as to entitle it to a monopoly upon that item. It consists of nothing more than a combination of ideas drawn from the existing fund of public knowledge. As was said in *Graham*, the claims in issue "must fall as not meeting the test of § 103, since the differences between them and the pertinent prior art would hav been obvious to a person reasonably skilled in that art." — U.S. at —, 34 *Law Week* 4129. That appellant was the first skilled in the art who actually produced a refrigerated vacuum bulk milk tank apparatus does not amount to patentable invention under our law.

The decision of the district court is

AFFIRMED.

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[11] See *e.g.*, *Harris* v. *National Machine Works*, 171 F. 2d 85 (10 Cir. 1948); *Ray-O-Vac Co.* v. *Goodyear Tire & Rubber Co.*, 136 F. 2d 159 (7 Cir. 1943), *aff'd* 321 U.S. 275.

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

October Term, 1965

No. 21624

D. C. Docket No. 2954—Civil Action

ZERO MANUFACTURING COMPANY, INC., *Appellant,*

versus

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Appellee.*

Appeal from the United States District Court for the Southern District of Mississippi

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Before WISDOM and COLEMAN, Circuit Judges, and DAWKINS, District Judge.

Judgment

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Mississippi, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed;

It is further ordered and adjudged that the appellant, Zero Manufacturing Company, Inc., be condemned to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

March 22, 1966

Issued as Mandate: May 10, 1966

(May 2, 1966)

On Petition for Rehearing

Before WISDOM and COLEMAN, Circuit Judges, and DAWKINS, District Judge

PER CURIAM:

The petition for rehearing is denied.

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JOHN F. DAVIS, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1966.

ZERO MANUFACTURING COMPANY, INC.,
Petitioner,

v.

MISSISSIPPI MILK PRODUCERS ASSOCIATION,
Respondent.

No. 416.

BRIEF

In Opposition to Petition for Certiorari.

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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1966.

ZERO MANUFACTURING COMPANY, INC., Petitioner, v. MISSISSIPPI MILK PRODUCERS ASSOCIATION, Respondent.	No. 416.

BRIEF

In Opposition to Petition for Certiorari.

STATEMENT.

The Petition for Certiorari should be denied because it presents no question of such broad and general interest as should be considered by the Supreme Court. The case is only a conventional patent case wherein two patents were held invalid because of obviousness. The decision of the Fifth Circuit Court of Appeals was entered on March 22, 1966, subsequently to this Supreme Court's decisions in **Graham v. John Deere Company**, 383 U. S. 1, 15 L. Ed. 2d 545, and **United States v. Adams**, 383 U. S. 39, 15 L. Ed. 2d 572. It discussed these cases and was

based explicitly thereon. The petition presents no new issue for consideration by the Supreme Court.

The patents involve bulk milk vacuum tanks. The first patent claims patentability in refrigerating a milk tank. In September 1952, when petitioner filed its patent application, there simply was no invention in refrigerating a milk tank by applying an old refrigeration system already previously used on a bulk milk tank, to an old bulk milk vacuum tank. The Trial Court so held, and the Court of Appeals affirmed.

Petitioner's other patent in suit was directed to the idea of putting a hole through the cylindrical side wall of the tank to provide access for cleaning and inspection. The Trial Court held that such an opening was shown in United States Patent No. 1,437,857 granted to Nitch and that there was no invention in putting such an opening in a milk tank. The Court of Appeals agreed.

ARGUMENT.

The petitioner attacks the decisions below primarily on the ground of asking the Supreme Court to judge the credibility of an expert witness in a particular case. This the Supreme Court is hardly in a position to do, and this involves no general question of national interest. Furthermore, how can it be assumed that the testimony of a particular witness controlled the decisions of the Trial Court and Court of Appeals? Finally, the expert was fully qualified in the art of refrigerating milk tanks, and his testimony was correct.

Petitioner's statement argues commercial success of the petitioner. The Courts below were advised of this but properly and conventionally applied the rule that commercial success cannot convert the obvious into a patentable invention.

In conclusion, it is submitted that this is a straightforward and very conventional patent infringement case already decided against the petitioner, upon the latest decisions of this Supreme Court in patent cases, and no new issue is presented to the Supreme Court for consideration, nor is any question raised of broad general interest as distinguished from the private dispute between two litigants.

Respectfully,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 416

ZERO MANUFACTURING COMPANY, INC., *Petitioner*

v.

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Respondent*

REPLY BRIEF TO RESPONDENT'S OPPOSITION TO PETITION FOR CERTIORARI

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 416

ZERO MANUFACTURING COMPANY, INC., *Petitioner*

v.

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Respondent*

REPLY BRIEF TO RESPONDENT'S OPPOSITION TO PETITION FOR CERTIORARI

The respondent's argument to the Court is essentially as follows:

1. Petitioner is asking the Supreme Court to judge the credibility of an "expert witness".

2. It cannot be assumed that the evidence of the particular witness controlled the decisions.

3. In any event, the expert was fully qualified in the art of refrigerating milk tanks.

4. The Court below properly recognized the rule of commercial success; and

5. The issue is not one of broad interest.

In reply to the foregoing, the petitioner respectfully points out:

1. There is no question of the *credibility,* as such, of respondent's "expert". The issue which the petitioner raises is whether an opinion as to what is or is not obvious "to a person having ordinary skill in the art" to which the subject matter of the invention pertains can invalidate a patent under 35 U.S.C. 103 if that opinion is from a person admittedly *not* skilled in the art. Since 35 U.S.C. 103 is explicit that the question of obviousness is to be determined as viewed by a person having ordinary skill in the art, it would seem elemental that such views are requisite if the statutory provision is to be applied to invalidate a patent.

2. The lower court decisions fairly parroted respondent's "expert" in invalidating petitioner's patents. Respondent has never contended that petitioner's experts suggested that petitioner's invention was obvious. To the contrary, the testimony of Professor March, a true expert in the field, concerned the trade and the revolutionary impact the invention has had in dairy farming. Respondent's suggestion at this late date that the decisions were based upon other than Dean Fischer's testimony is a red herring.

3. Contrary to respondent's implication, there is no testimony that Dean Fischer ever had anything to do with the refrigeration of milk tanks. His degree was in electrical engineering (R. 622.) Refrigeration was one of his hobbies (R. 623). But even if he could be considered a refrigeration expert, by no stretch of the imagination does this make him an expert in the dairy industry art. Dean Fischer was personable and articu-

late. But he was simply in no position to evaluate and testify concerning the effects of the prior teachings on a person skilled in the dairy industry art—particularly where such prior teachings appeared or proved in practice so impracticable as to lead away from, rather than towards, the successful invention.

4. Petitioner does not argue that the lower courts failed to recognize the rule of commercial success. Petitioner's complaint is that the Fifth Circuit Court misapplied the "doubt followed by acclaim" doctrine of *U. S.* v. *Adams,* 15 L. Ed. 2nd, 572, and the "long felt want" doctrine as applied in cited Second Circuit cases. On this, however, respondent fails to comment.

5. Petitioner fully appreciates that the Supreme Court must limit its full consideration to cases appearing to have national importance. Failure of the Court to grant certiorari is not indicative of the Court's agreement with the lower courts' decisions. Indeed, should the petition not be granted, the lower courts' decisions are still not binding as between other possible litigants involving the same patents should petitioner elect to pursue them. But, while petitioner, as any litigant, is disturbed by losing the case, it is also disturbed—perhaps more so—by *why* it lost.

It would seem axiomatic invention and inventors are important. The impacts of gun powder, the printing press, the steam engine and the airplane on civilization are self-evident. John Kenneth Galbraith notes in *The Affluent Society*[1] that technological innovation is one of five basic ways to increase production—the output of the economic system, and that in recent times a growing share of the increase is attributable to tech-

[1] See Chapt. IX, Sec. III.

nological advance and a declining share to mere increases in capital and labor. Ultimately one of the species—perhaps the most important of those paid for technical advance—are patents.

For a period of over fifteen years from the *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950) to *Graham* v. *John Deere Co.*, 15 L. Ed. 2d 545, and *United States* v. *Adams*, 15 L. Ed. 2d, 572 (1966), this Court concerned itself with controversies, albeit important, but other than the criteria of patentability. With an intervening revision of the patent statutes, it is therefore not too surprising that the federal judicial circuits have markedly contrasted in their evaluation of patentability, as noted previously on page 14 of the Petition.

It is submitted that largely due to present patent trial practices—as exemplified by this case—problems concerning the sound application of 35 U.S.C. 103 have not been laid to rest by *Graham* v. *John Deere Co.* and *United States* v. *Adams, supra.* While trial courts may be faced with difficult choices where experts conflict, if they are to gage invention under 35 U.S.C. 103, they deserve better than they have been getting which should at least include the advice of experts skilled in the particular art involved.

Insofar as Counsel for petitioner can ascertain, the issue is novel. While its determination may relegate a number of expert experts now thriving in patent trial arenas to obsolescence, the exercise of judicial power in the patent field should gain in uniformity and predictability and seem less of a wheel of fortune than now regarded.

Although the natural reluctance of Courts—generally with minimal engineering training and experience—to embroil themselves in patent cases is appreciated, it is believed of *significant* national interest that this Court promptly invoke its powers of review whenever inconsistencies develop between Circuits or it appears that a particular circuit is not applying the correct standards of patentability.

A strong indication that the Fifth Circuit is not applying the standard of patentability found applicable in recent decisions by this Court and as applied by other circuits, may be found in the recent decision of *Up-Right, Inc.* v. *Safway Products, Inc. et al.*, 150 USPQ 579 (5 Cir. 1966) where Senior Judge Jones (who presided as Chief Judge in *Adams et al.* v. *United States*, 141 USPQ 361 (C. Cls. 1964)) was a member of the appeal panel. Here Senior Judge Jones (sitting with the Fifth Circuit Court of Appeals) dissented from action finding a patent invalid for want of "non-obviousness" over the prior art, for reasons, in part, as follows:

> I respectfully dissent. I feel strongly that the patent in suit passes the test of non-obviousness, formulated by the Patent Act of 1952, 35 U.S.C. Sec. 103 (1964), and construed by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2d 545, 148 USPQ 459 (1966). The majority of this court, and the court below, although professing to be guided by the factual inquiries specified in Graham, in my judgment misapply these tests and thereby reach an erroneous legal conclusion.
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> A patent awarded by the Patent Office is to be presumed valid, and the burden of establishing

invalidity falls on the party asserting it. 35 U.S.C. SEC. 282 (1964). "The primary responsibility for sifting out unpatentable material lies in the Patent Office." Graham, supra, at 18, 148 USPQ at 467. The majority here gives emphasis to the fact that none of the prior art considered by the District Court was before the Patent Office when it granted the patent in suit. But the party attacking the validity of a claim can always find references which the Patent Office did not consider. The question is whether the references are of such significance that the presumption of validity is overcome and the decision of the Patent Office may be set aside. Otto v. Koppers Co., 246 F.2d 789, 114 USPQ 188 (4th Cir. 1957), cer. denied, 355 U.S. 939, 116 USPQ 602 (1958). Nowhere has appellee attempted to show directly that the prior art which the Patent Office did consider was in fact insufficient in comparison with the references introduced before the District Court.

* * * * *

In ascertaining the obviousness or non-obviousness we are not limited to an examination of prior art. If validity is in question, then "commercial success, long felt but unsolved need, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter * * *. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.". Graham, supra, at 17-18, 148 USPQ at 467. Admittedly commercial success in itself does not support patentability, Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147, 153, 71 S.Ct. 127, 95 L.Ed. 162, 87 USPQ 303, 306 (1950), but once novelty and utility have been established, as they have been with respect to the patent in suit, commercial success weighs heavily against contention that the claims in issue were obvious to skilled mechanics in the same field.

Loom Co. v. Higgins, 105 U.S. 580, 26 L.Ed. 1177 (1881); Otto v. Koppers Co., supra, at 799-800, 114 USPQ at 197.

* * * * *

My conclusion is that appellant had *invented* something, something not obvious to others, something not a mere mechanical improvement. It is almost a reflection on the skilled artisans and mechanics of the vast building trade of this country to hold that they overlooked so important a development, but plodded along with clumsier and more expensive methods. I prefer to believe in the skill of these mechanics and artisans. It is plain they welcome the Up-Right scaffold.

By holding the patent in suit invalid, we have done not only an injustice to appellant but have placed an unreasonable and discouraging burden on future inventors. For these reasons I cannot join the majority.

Not unexpectedly, respondent in its brief attempts to depreciate petitioner's invention. The invention involves the process of milking. Almost everyone is directly affected by milk. As Professor March pointed out, the bulk milk tank system is rapidly displacing the can system in the United States and the trend is towards petitioner's particular system which includes the vacuum bulk milk tank. The elimination of the releaser in petitioner's system eliminates a cause of milk rancidity. The reserve vacuum decreases vacuum variation at the teats—a major contributor to mastitis. The vacuumized tank lends itself to effective automatic cleaning. As more fully outlined in the Petition, these and other advantages make petitioner's invention a major advance in the dairy industry. Thus we are not involved with a door knob or eraser on a pencil,

but an important technological advance which directly affects us all.[1]

CONCLUSION

The U.S. Circuit Court of Appeals for the Fifth Circuit has over-reacted to this Court's decisions in *Graham* v. *John Deere Co.* and *United States* v. *Adams, supra.* This is evidenced by the instant case and delineated by Senior Judge Jones' vigorous dissent in the subsequent case of *Up-Right, Inc.* v. *Safway Products, Inc., supra.* Important issues and an important invention is involved. The petition for a writ of certiorari should be granted.

Respectfully submitted,

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[1] Contrary to the lower court decisions, history will probably side with Zero as to the importance of its development. Aside from the commercial success and other indicia of invention presented in evidence, petitioner was one of 16 concerns chosen to present a mechanical display at the 1961 Mechanical Industries Patent Exhibit in the Department of Commerce Building, Washington, D. C. held in celebration of the 125th Anniversary of the U. S. Patent Office. In a recent industrial arts exhibition in Moscow, USSR, a Zero T-20 Bulk Milk Tank manufactured by a European licensee, Eurozero, was awarded a gold medallion for its highly technical level, originality of solution, economy of use, sturdy construction, productivity and ease of handling.

CERTIFICATE OF SERVICE

A copy of the foregoing Reply Brief was mailed, airmail first class, to Edmund C. Rogers and John T. Rogers, Esquires, Kingsland, Rogers, Ezell, Eilers & Robbins, 121 South Meramec Avenue, St. Louis, Missouri 63105, and W. E. McIntyre, Jr., Esquire, Brandon, Mississippi, Counsel for Defendant-Respondent, on October 4, 1966.

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